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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,589	12/28/2001	Stephen T. Kuehn	S16.12-0128	1702

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EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,589

Applicant(s)

KUEHN ET AL

Examiner

Aaron Roane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the handle" in line 5. There is insufficient antecedent basis for this limitation in the claim.

The examiner suggests making the change from "the handle" to -a handle--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrison et al.

(USPN 5,972,030).

Regarding claims 1, 4, 5, 7 and 8, Garrison et al. teach all of the limitations of these claims. Garrison et al. teach an apparatus that can hold an annuloplasty ring including:

- a) a holder body 70 configured to hold an annuloplasty ring;
- b) a handle coupling 80 mounted with the holder body configured to couple to the tip of a handle, where the opening is raised and may be used for gripping;
- c) a handle; and
- d) a release mechanism (various types of interconnection means listed in beginning on col. 18, line 60 and ending on col. 19, line 2.) coupled to the handle coupling 82, a non-circular slot or opening, see col. 14-18.

Regarding claims 2 and 3, Garrison et al. further disclose that the device includes a spring to bias the handle coupling into a lock position, see beginning on col. 18, line 60 and ending on col. 19, line 2. The release mechanism and spring inherently transmit a force to provide a lock or unlocked position.

Regarding claim 10, Garrison et al. further disclose the claimed invention. The surface (the surface of 80) about the opening or slot (82) is raised and provides a gripping surface to which the handle tip (26) grips and/or locks to.

Regarding claim 11, Garrison et al. further disclose many embodiments wherein the handle coupling slides into the holder body in a direction that is parallel to a plane of the

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holder body, see figures 12A and 12B. A plane of the holder body is so broad that there are infinite number of planes of the holder body that are parallel to the motion or slide direction shown in figures 12A and 12B.

Regarding claim 12, Garrison et al. further disclose a handle (10), see col. 12, lines 18-38 and figures 1, 3 and 4.

Regarding claims 6 and 13, Garrison et al. further disclose a protuberance (34) on the tip (26) of the handle (10), see col. 12, lines 18-60 and col. 18 and 19 and figure 1-4.

Regarding claim 14, Garrison et al. further disclose the release mechanism being a button (44) see col. 12, lines 18-38 and figure 2.

Regarding claims 15 and 16, Garrison et al. further disclose a handle coupling comprising a clip (124) that is slidable within the holder body and provides locking and release capability, see col. 17, lines 30-58 and figure 12A.

Regarding claim 17, Garrison et al. disclose a handle (10) comprising an elongate shaft (20), a gripping portion (28) that includes ribs (the ribbed or grooved button 30 section with the handle 28) and a tip (26) coupled to the other end of the elongate shaft (with respect to the gripping portion), see col. 12 and figures 1-4.

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Regarding claim 18, Garrison et al. further disclose flat portions various flat sections on 28) on the handle, see figure 1.

Regarding claim 19, Garrison et al. further disclose a tip with walls (flat sides in 36 and 39 are located) that are aligned with some of the flat portions on the handle (the side flat surfaces 90° away from the flat portion with the button therein), see figures 1 and 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrison et al. (USPN 5972030) in view of Rhee et al. (USPN 6019739).

Regarding claims 9 and 21, Garrison et al. teach all of the limitations of these claims as described above except for the opening and walls of the tip of the handle being tapered. Additionally Garrison et al. list a large number of equivalent locking/release or interconnection means, see beginning on col. 18, line 60 and ending on col. 19, line 2. Rhee et al. teach a similar device including a body, handle coupling, and handle where the body has a tapered opening for receiving the tapered tip of a handle (figure 1).

Therefore, at the time of invention it would have been obvious to one of ordinary skill in the art to modify the device of Garrison et al., as taught by Rhee et al., to include a handle coupling mechanism having a tapered opening and tip with tapered walls as part of a suitable means for coupling the handle to the holder body.

Response to Amendment

The examiner acknowledges the amendments made to the claims. However a 112 2nd paragraph indefinite rejection remains for claim 1.

With regards to the remarks on page 6, lines 4-14, referring to the spring, abutting surface, knob and release mechanism. The claims have reaffirmed and have been separated as much as possible in order to provide a more clear and more concrete presentation of the claimed subject matter.

Beginning on page 6, the next to last line, Applicant states that the device of Garrison et al. is different from that of the claimed invention, because Garrison et al. disclose a handle coupling attached to the distal end of the handle. It may be true that the device of Garrison et al. is indeed different from the disclosed invention. However, the Garrison et al. device does meet the claimed invention limitations as put forth by the claim language.

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The handle coupling has stated in the above claim rejections is (80) not (26) of the Garrison et al. reference.

Beginning on page 7, line 5, Applicant also suggests that Garrison et al. disclose a release mechanism that does not or is not coupled to the holder body. This is incorrect, Garrison et al. disclose a large number of equivalent locking/release or interconnection means, see beginning on col. 18, line 60 and ending on col. 19, line 2 that may be used. Also the claim language "a release mechanism coupled to the handle coupling" does not distinguish the differences, if any, between the claimed invention and the Garrison et al. reference.

Additionally, the claim language does not provide enough functional language to distinguish between the protuberances cited above, the catch and the protuberance of the claimed invention. In view of all the above, the rejections stand and are reaffirmed. This action is final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (703) 305-7377. The examiner can normally be reached on 9am - 5pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A.R. *A.R.*
September 22, 2003


JOHN MULCAHY
PRIMARY EXAMINER